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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/671,554 | 09/29/2003 | Thomas D. Petersen | PETERSEN-17 | 1351 |
| 7590 05/28/2009 | | | | |
| H. JAY SPIEGEL P.O. BOX 11 Mount Vernon, VA 22121 | | | EXAMINER SWIGER III, JAMES L | |
| | | | ART UNIT 3775 | PAPER NUMBER |
| | | | MAIL DATE 05/28/2009 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/671,554

Applicant(s)

PETERSEN, THOMAS D.

Examiner

JAMES L. SWIGER

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/29/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

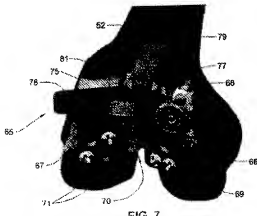
Election/Restrictions

Applicant's election without traverse of Group II, claims 20-41 in the reply filed on 1/21/2009 is acknowledged.

Claims 1-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/21/2009.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings submitted on 9/29/2003 are of unacceptable quality for examination. Critical areas appear to be completely shaded out, or are black. For example:



All drawings are of similar quality.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid

abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The abstract is too long. Applicant is reminded that:

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 15 lines of text.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen (US Patent 5,606, 590), hereafter "P590" in view of Petersen (US Patent 4, 524, 766) hereafter "P766." P590 discloses a system for locating the center of a femoral head (6) of a patient (see Fig. 1 and 2), comprising a frame (60) a laser generator (100) which is mountable (see fig. 2) and pivotable on a frame (124, and Col. 5, lines 5-20), and a target (90) mountable over the femoral head (Fig. 2), which aids in directing the surgeon to use the laser beam generator. Petersen describes the use of the laser in aligning and guiding in preparation for obtaining anatomical data of a patient prior to surgery including where a laser is used and reconfigured to shine light onto a

target (such as a scale which is used to determine limb placement) and where then a surgeon uses the light to align the leg. In this respect the patient's ankle is used as a target as a reference point, as is best ascertained in applicant's Figure 17. Additionally, in obtaining measurements of the leg placement, various knobs or adjusting means are used (see Fig. 2), which allow the device to be best positioned as required for the surgical procedure.

P590 discloses the claimed invention except for an adjustable distal femoral resector or a frame that has the specific capability of connecting to the intercondylar notch to help with targeting the center of the femoral head of a patient. P766 discloses a system having a distal femoral resector that connects to the knee and provides means to interface with a system to be useful in an alignment system (see fig. 5, and Col. 4, lines 1-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made construct the device of P590 having at least the adjustable femoral resector of P766 to assist with accurate placement of the system with respect to the patient's anatomical characteristics, so the femoral head can be more precisely located.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER whose telephone number is (571)272-5557. The examiner can normally be reached on M-F 9-530.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L. SWIGER/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775